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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/575,974	08/31/2006	Mu-Hyun Jin	B-5950PCT 623428-3	8899

36716 7590 08/09/2007
LADAS & PARRY
5670 WILSHIRE BOULEVARD, SUITE 2100
LOS ANGELES, CA 90036-5679

EXAMINER

SIMMONS, CHRIS E

ART UNIT	PAPER NUMBER
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1614

MAIL DATE	DELIVERY MODE
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08/09/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/575,974	JIN ET AL.	
	Examiner	Art Unit	
	Chris E. Simmons	1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/14/2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☒ Claim(s) 6-7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>11/07/2006</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims 6 and 7 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 6 and 7 attempts to limit the claims by using intended use language (e.g., for anti-wrinkle cosmetics). Product claims that recite intended uses are not limited by those intended uses.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-2, 5-7 rejected under 35 U.S.C. 102(b) as being anticipated by the abstract of JP 2001131050 ('050).

Instant claims are drawn to a composition comprising in a compound selected from the formula recited in claims 1 and 2. Prepared in certain forms (e.g., lotion (claim 5), gel, liquid, cream (claim 4), etc.).

'050 teaches the use of xanthoxol in a cosmetic lotion. Xanthoxol is a compound as recited in instant claims 1 and 2 when R = hydrogen. The "ointment" and "cream" recited in claim 4 are reasonably encompassed by the "lotion" taught in '050.

Claim Rejections - 35 USC § 103

1. Claim 3 is rejected under 35 USC 103(a) as being unpatentable over the abstract of JP 2001131050 ('050).

Determination of the scope and content of the prior art (MPEP 2141.01)

'050 discloses the use of xanthoxol in a cosmetic lotion.

Ascertainment of the difference between the prior art and the claims (MPEP 2141.02)

'050 does not disclose expressly the amount of xanthoxol in the range of 0.000001 to 10% the composition by weight.

Finding of prima facie obviousness

At the time of the invention it would have been obvious to a person of ordinary skill in the art to make a lotion comprising the claimed concentrations of xanthoxol.

It is commonly practiced in the art of topical compositions to optimize the utility of a composition by altering concentrations of its ingredients. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to optimize the topical composition of '050 by altering concentrations of xanthoxol. One of ordinary skill in the art would expect to alter viscosity of a topical composition by altering the concentration of water and gelling agents. Unless there is an illustration of criticality of the claimed concentration, the claimed invention of claim 3 lacks patentability.

Rational and Motivation (MPEP 2142-2143)

The suggestion/motivation for doing so would have been to optimize the amount of xanthoxol for therapeutic use.

Therefore it would have been obvious to alter the concentration of the compound through routine experimentation to obtain the claimed invention as specified in claim.

A reference is good not only for what it teaches by direct anticipation but also for what one of ordinary skill in the art might reasonably infer from the teachings. (*In re Opprecht* 12 USPQ 2d 1235, 1236 (Fed Cir. 1989); *In re Bode* 193 USPQ 12 (CCPA) 1976). In light of the forgoing discussion, the Examiner concludes that the subject matter defined by the instant claims would have been obvious within the meaning of 35 USC 103(a). From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

Conclusion

4. No claims are allowed
5. The following is pertinent art that was not used for this office action:
 - a. US 2005/0220810
 - b. Katsambas et al., "Disorders of pigmentation: unapproved treatments", *Clinics in Dermatology*; Volume 20, Issue 6, November-December 2002, Pages 649-659

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chris E. Simmons whose telephone number is (571) 272-9065. The examiner can normally be reached on Monday - Friday from 7:30 - 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel can be reached on (571) 272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Chris Simmons
Patent Examiner
AU 1614

July 31, 2007

Ardin H. Marschel 8/5/07
ARDIN H. MARSCHEL
SUPERVISORY PATENT EXAMINER

JDA